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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,720	08/25/2003	Joseph H. Lyons	1857.2030000	9846
28393	7590	04/04/2006	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVE., N.W. WASHINGTON, DC 20005			CYGAN, MICHAEL T	
			ART UNIT	PAPER NUMBER
			2855	

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Advisory Action Before the Filing of an Appeal Brief	Application No. 10/646,720	Applicant(s) LYONS, JOSEPH H.	
	Examiner Michael Cygan	Art Unit 2855	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☒ Other: See Continuation Sheet.


MICHAEL CYGAN, PH.D.
PRIMARY EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because: the arguments against the combination of references have previously been substantively addressed. A structural feature claimed by its characteristics is met by a reference which possesses the same characteristics; here, both Zumbach and Carraras teach probe designs which have no low low sensitivity areas; "low sensitivity areas" being understood with reference to applicant's specification

Continuation of 13. Other:

1. With respect to confusion over the restriction, the body of the rejection clearly restricts invention I from invention II and invention II. The numbering error (33 rather than 38) which appeared in the accompanying form does not detract from the fact that restriction was made between invention I and inventions II and II (inventions II and III were not restricted from each other since such was not necessary at this point). Applicant failed to timely request clarification; see 710.06.
2. With respect to the question of burden, there is more than one way to burden the office.
 - a. One way to burden the office is to present claims requiring a new search or consideration. Here, claims 33 and 38 require further search or consideration, since the new limitations concerning a flat metal plate have not previously been examined in the context of the system of claim 26 or the method of claim 34. This adds a burden to the examination process, as is recognized in the limitations on after-final amendments.
 - b. A second way to burden the office is to attempt to switch back and forth between inventions. The examiner previously permitted applicants to cancel all claims in a RCE and present new claims directed to a new invention. The examination process has been focused on the particular details of these new claims; the old claims have not been mentioned. To switch back to the other set of original claims is akin to permitting a shift between different inventions; this is impermissably burdensome to the examination process as recognized in MPEP 819.
 - c. A third way to burden the office is to bring numerous inventions on appeal. As noted above, amendments after final which do not simplify the issues for appeal may be refused. Here, the inclusion of additional claims, which
 - d. In the remarks which accompanied the amendments cancelling original claims 1-18, applicant remarked that applicant reserved the right to "prosecute similar or broader claims in a continuation application." Applicant failed to mention the possibility that these claims would be resurrected in the current application; unfairly leading the Office to believe that examination would pursue on a single invention rather than becoming a multi-headed hydra .
3. With respect to the intent to appeal, it would serve no Office purpose to require two appeals to deal with the separate issues which have been fully, if separately examined. For this reason, should applicant wish to appeal the final rejection of claims 19-25, applicant may submit with the appeal brief an amendment adding only the exact text of the claims which were previously considered. Claims adding further scope (such as proposed new claims 33 or 38) will cause the amendment to fail and be unentered. The Office will enter the amendment and allow such claims to be considered for appeal.